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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,243	12/15/2000	Lok Yan Leung	AUS920000814US1	2747

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EXAMINER

COLIN, CARL G

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 03/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/738,243	Applicant(s) LEUNG ET AL.	
	Examiner Carl Colin	Art Unit 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8-14,17-19,26-30,33-39 and 42-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8-14,17-19,26-30,33-39 and 42-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u>see att.</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Response to Arguments

1. In response to communications filed on 2/15/2005, Applicant amends claims 1, 8, 11, 26 and 36; and cancels claims 6-7, 15-16, 20-25, 31-32, 40-41, and 45-46. Examiner reopens prosecution. The following claims 1-5, 8-14, 17-19, 26-30, 33-39, 42-44 are presented for examination.

1.1 With regard to the use of JAVA trademark, on page 8, each letter (all the letters) should be capitalized. Applicant's remarks, pages 10-14, filed on 2/15/2005, with respect to the rejection of claims 1-46 have been fully considered, but are moot in view of the new ground(s) of rejection. Applicant has amended claims 1, 8, 11, 26, and 36 and cancels claims 6-7, 15-16, 20-25, 31-32, 40-41, and 45-46. Claim 1 now contains the limitation of canceled claims 1-7. Claim 8 has been amended to be in independent form. Claim 11 now contains the limitations of canceled claims to include the limitations of claims 6-7; claims 26 and 36 have limitations of canceled claims 31-32, and 40-41 respectively. Upon further consideration a new ground of rejection is made in view of Samar.

Specification

2. The use of the trademark JAVA has been noted in this application on page 8. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks. Appropriate correction is required

Claim Objections

3. **Claims 11 and 36** are objected to because they are substantial duplicates of other claims. Applicant is advised that should **claim 1** be found allowable, **claim 11** will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. Applicant is also advised that should **claim 26** be found allowable, **claim 36** will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.1 **Claims 1-5, 8-14, 17-19, 26-30, 33-39, 42-44** are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,778,072 to **Samar**.

4.2 As per claims 1, 11, 26, 36, 8, 17, 33, and 42, **Samar** discloses a method and system in a data processing system for executing cryptographic operations comprising: responsive to a request to perform a cryptographic operation, dynamically selecting whether to perform an encryption operation with a smart card or an encryption operation using an encryption service based on whether the user has a smart card or based on the encryption scheme used, for example (see column 4, line 66 through column 5, line 18 and column 5, lines 47-62 and column 7, lines 10-33 and column 8, lines 38-61) that meets the recitation of dynamically selecting between one of a software process and a hardware process within the data processing system for performing the cryptographic operation based on a policy to form a selected process. **Samar** discloses the limitation of performing the cryptographic operation using the selected process, for example (see column 7, lines 10-36 and column 8, lines 38-61); wherein the cryptographic operation is an encryption of data using a key, for example (see column 7, lines 10-36 and column 8, lines 38-61). **Samar** discloses the step of performing the cryptographic operation includes converting the software key to a form usable by the smartcard if the key is in an unusable form by the smartcard process (column 7, lines 10-45; column 8, lines 18-61) that meets the recitation of wherein the key is a software key and the selected process is the hardware process and further comprising: converting the software key into a hardware form useable by the hardware process for performing the cryptographic operation.

Samar discloses the step of performing the cryptographic operation includes: a hardware key can be obtained from the smartcard and be made usable by the software process when key is in an unusable form by the software process that meets the recitation of wherein the key is a hardware key and the selected process is the software process and further comprising: converting

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the hardware key into a software form useable by the software process for performing the cryptographic operation, for example (see column 5, lines 38-62; column 7, lines 10-36 and column 8, lines 18-61).

As per claims 2, 19, 27 and 44, Samar discloses the limitation of wherein the policy includes selecting the one based on available resources to perform the cryptographic operation, wherein the identified available resources include available processing resources and memory, for example (see column 3, line 63 through column 4, line 7 and abstract).

As per claims 3, 10, 28, and 35 Samar discloses the limitation of wherein the policy includes selecting the software process that meets the recitation of selecting one resulting in a fastest completion of the cryptographic operation, for example (see column 8, lines 54-61).

As per claims 4 and 29, Samar discloses the limitation of wherein the selecting step includes: selecting the one using a preference associated with the request, for example (see column 3, line 63 through column 4, line 7).

As per claims 5 and 30, Samar discloses the limitation of wherein the preference is for the hardware process to performing the cryptographic operation, for example (see column 3, line 63 through column 4, line 7).

As per claims 9 and 34, Samar discloses the limitation of wherein the policy comprises a set of rules used to minimize available resources consumed in performing the cryptographic operation, for example (see column 3, line 45 through column 4, line 7).

As per claims 12 and 37, Samar discloses the limitation of wherein the cryptographic operation is one of a message digest and a public-private key encryption, for example (see column 8, lines 18-61).

As per claims 13, 14, 38 and 39, Samar discloses the limitation of wherein the request is received from the application using an application program interface call made by the application, for example (see column 7, lines 10-30).

As per claims 18 and 43, Samar discloses the software process providing key to the hardware for performing cryptographic operation that meets the recitation of wherein the key is a software key and the selected process is the hardware process and further comprising: converting the software key into a hardware form useable by the hardware process for performing the cryptographic operation, for example (see column 7, lines 10-45; column 8, lines 18-61).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 571-272-3862. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

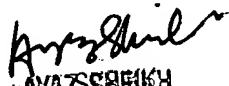
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

cc

Carl Colin

Patent Examiner

March 7, 2005


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100